

REMARKS

Claims 5, 8, 9, 11-16, 20 and 23 are all the claims pending in the application.

I. Response to Rejection of Claims 5, 8-9, 20 and 23 under 35 U.S.C. § 103(a)

Claims 5, 8-9, 20 and 23 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Terada et al. (WO 03/052045) in view of Namikawa et al. (WO 02/05975).

The rejection is respectfully traversed for the reasons for record and for the following additional reasons.

It is submitted that one of ordinary skill in the art would not have been motivated to modify Terada based on the disclosure of Namikawa.

The Examiner asserts that Namikawa teaches that in addition to the material obtained by causing the compound, that has one unsaturated double bond or more in the molecule, to contain into the pressure-sensitive adhesive polymer, there may be employed preferably rubbers, natural resins, synthetic resins such as polyethylene terephthalate, phenol resin, polyester resin, alkyd resin, epoxy resin, polycarbonate, cellulose nitrate, poly(vinylidene fluoride), polypropylene, polyimide, nylon 6, nylon 66, poly(methyl methacrylate), methyl methacrylate/styrene copolymer, ethylene fluoride/propylene copolymer, etc. (see page 5, line 19 to page 6, line 8), and thus it would have been obvious to one of ordinary skill in the art to have substituted the cleaning layer comprising (meth)acrylic acid of Terada with a cleaning layer comprising polyimide resin. In addition, the Examiner notes that Namikawa is not limited to the Examples.

Although Namikawa discloses "polyimide" broadly, the Examiner cannot ignore the other teachings of Namikawa or the teachings of Terada.

Terada discloses that the cleaning layer exhibit a 180° peel adhesion of 0.20 N/10 mm or less, preferably from about 0.010 to 0.10 N/10 mm; otherwise, the cleaning layer adheres to the

non-cleaning area in the device during conveyance, possibly causing conveyance troubles.

Namikawa teaches the same problem and teaches the use of materials, such as acrylic polymers on page 11. Specifically, Namikawa also discloses that the 180° releasing adhesive force is not more than 0.20 N/10 mm, preferably about 0.010 to 0.10 N/10 mm. *See* page 10, lines 7-9. As specific materials, Namikawa discloses the use of acrylic polymers that contain (meth)acrylic acid and/or (meth)acrylic ester. *See* page 11, lines 3-7.

Given the desire in Terada to use a cleaning layer exhibit a 180° peel adhesion of 0.20 N/10 mm or less and the teaching in Namikawa that acrylic polymers provide such a cleaning layer, one of ordinary skill in the art would not be lead to modify Terada by using a polyimide. Indeed, it is submitted that is no teaching or suggestion in Namikawa that the use polyimide provides a cleaning layer exhibit a 180° peel adhesion of 0.20 N/10 mm or less, and thus there is no apparent reason to modify Terada as proposed by the Examiner.

In addition, the Examiner asserts that poly(methylmethacrylate) and polyimide are “art recognized equivalents”. The Examiner appears to be taking the position that merely because polyimide and poly(methylmethacrylate) are disclosed as being employable in an PSA polymer, they are equivalent.

The Examiner’s position is contrary to MPEP §2144.06, which states “the equivalency must be recognized in the prior art, and cannot be based on applicant’s disclosure or the mere fact that the components at issue are functional or mechanical equivalents.” Simply because both poly(methylmethacrylate) and polyimide can be added to a PSA polymer is insufficient to support the position that poly(methylmethacrylate) and polyimide are equivalents.

In this regard, it is noted that principles such as “art recognizable” without providing an explanation of the applicability to the facts of the present case is insufficient to establish a *prima*

facie case of obviousness. *See* Federal Register Notice of September 1, 2010 at page 53645.

Furthermore, it is submitted that since Terada does not disclose the use of polyimide and since Namikawa neither contains an Example where polyimide is used nor mentions silicone, one of ordinary skill in the art would not reasonably expect each of the relative intensities of the recited fragment ions in the cleaning layer to be within the claimed ranges.

For at least the foregoing reasons, it is respectfully submitted that a *prima facie* case of obviousness has not been established, and that claims 5 and 8 are patentable over the cited art.

In addition, claims 9, 20 and 23 depend from claim 5 or 8, and thus it is submitted that these claims are patentable for at least the same reasons as claim 5 or 8.

Accordingly, withdrawal of the rejection is respectfully requested.

II. Response to Nonstatutory Obviousness-type Double Patenting Rejection

Claims 5, 8-9, 20 and 23 are rejected on the ground of nonstatutory obviousness-type double patenting rejection over claim 14 of U.S. 7,575,790 in view of Namikawa.

The rejection is respectfully traversed.

Since the '790 patent corresponds to Terada above, Applicants respectfully traverse the rejection for the reasons set forth above in Section I.

Accordingly, withdrawal of the rejection is respectfully requested.

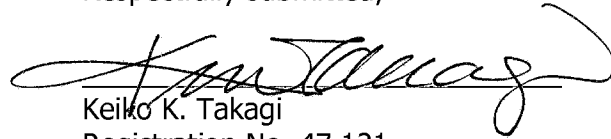
III. Conclusion

In view of the above, reconsideration and allowance of claims 5, 8, 9, 11-16, 20 and 23 is respectfully requested.

If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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